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10/15/07

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DATE SENT: Dec 15, 2003

SUBJECT: 09/422,675 ; Jacquinet-7

No. of pages (including this cover sheet): 5

FROM: Sheridan Neimark

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Browdy and Neimark

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: JACQUINOT=7

| | | |
|-------------------------------|---|-----------------------|
| In re Application of: |) | Art Unit: 1765 |
| Eric JACQUINOT |) | Examiner: D. DEO |
| Appln. No.: 09/427,675 |) | Washington, D.C. |
| Date Filed: October 27, 1999 |) | Confirmation No. 3607 |
| For: NEW ABRASIVE COMPOSITION |) | August 1, 2003 |
| FOR THE INTEGRATED... |) | |

REQUEST FOR ENTRY OF DECLARATION

Mail Stop _____
Honorable Commissioner for Patents
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Applicants are in receipt of Paper No. 25, an
Advisory Action mailed July 24, 2003, which states in the last
line thereof as follows:

The Declaration by Dr. Jacquinot is
acknowledged; however, it has not been
considered because of untimely filing.

Applicants request entry and consideration of such
Declaration.

First, applicants respectfully note that such
Declaration was filed with a Request for Reconsideration filed
July 14, 2003, and the Notice of Appeal was not filed until

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one day later, namely on July 15, 2003. The Rule in question is 37 CFR 1.195 which states in part that

... declarations... submitted **after** the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented. (emphasis added)

Thus, according to said Rule 195, a showing is only required if a Declaration is submitted **after** filing an appeal, but the clear implication is that no such showing is required **before** an appeal is filed, as in the present case. Accordingly, consistent with Rule 195, the Declaration of Dr. Jacquinot which was filed a day before the appeal was filed is timely rather than untimely filed, and should be entered.

Nevertheless, so that there will be no doubt, applicants have good and sufficient reasons why such Declaration was not presented earlier, as follows:

The Grover et al USP '917 was cited for the first time in the Office Action mailed April 10, 2002. Applicants replied with what they considered to be strong arguments against the rejection on December 26, 2002, at that time believing their arguments would overcome the rejection, and that no costly experiments would have to be conducted.

It was only when the rejection was repeated in the final Action mailed January 15, 2003, that applicants realized that they would need to have expensive comparative tests

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conducted to support their position, and consequently the testing procedure was not begun until after issuance of such Final Rejection mailed January 15, 2003.

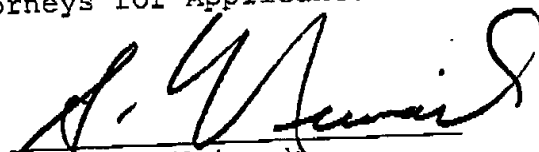
The cost of such experiments and the fact that applicants previously believed that no such tests would be necessary constitute good and sufficient reasons why the tests which resulted in the Declaration were not conducted earlier. Upon completion of these tests, the Declaration was filed on, as indicated, July 14, 2003.

Applicants request that such Declaration be entered at least for purposes of applicants' Appeal.

Respectfully submitted,

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By


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